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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/369,570	08/06/99	TONCELLI	M DRAGO-P86-RE

IM22/0525

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EXAMINER

AFTERGUT, J

ART UNIT	PAPER NUMBER
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1733

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DATE MAILED:

05/25/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/369,570

Applicant(s)
Toncelli

Examiner
Jeff H. Aftergut

Group Art Unit
1733



☒ Responsive to communication(s) filed on Apr 21, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-7 and 14-20 is/are allowed.

☒ Claim(s) 8-13 and 21-38 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Reissue Applications

1. Claims 21-38 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The reissue claims have been broadened to omit the limitation relating to the exclusion of grooves or recesses on the rear face of the stone slab and additionally have omitted the limitation relating to the inclusion of a reinforcing layer between the coated non-twisted linear reinforcing elements and the rear face of the stone slab material. Both limitation were strenuously argued by applicant in the response dated 12-23-96 in the patented file where applicant argued that "also emphasis has also been added to the claim to establish that it is a rear face of the stone slab material which is free from grooves or recesses, because as will be pointed out, this is another

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distinction from the prior art.”, see page 5 of the response. Additionally applicant is referred to page 7 of the response dated 12-23-96 where applicant argues that “Clearly, Toncelli ‘015 calls for the formation of grooves, and the placement of the rods in the grooves, and then the placement of resin into the grooves. Applicant starts out with a non-grooved surfaces, and creates the formation of areas between which the resin is inserted by calling for the provision of the non-twisted linear reinforcing elements on to a rear face of a slab of stone material having a rear face free of grooves or recesses. This clearly removes all of the references of record, because the main references has been removed, and therefore the modifying references have also been removed.” Finally, the applicant is referred to page 4 where there is a discussion of the inclusion of claim 7 (which recited that a reinforcing material was disposed between the non-twisted reinforcement and the slab) in claim 1 was addressed and applicant stated in the response dated 12-23-96 of the patent “Claim 1 was also amended to include the subject matter of claim 7 and the additional limitation of hardening of the resin, both which limitations clearly distinguish claim 1 from the combination of references applied...”. The applicant is additionally advised that in the reasons for allowance in the patented file (to which there were no comments made by applicant in response to the same) the examiner clearly stated that the reason claim 1 was patentable over the prior art of record was “None of the prior art of record teaches disposing a reinforcing layer between the linear reinforcing elements and the rear face of the slab of stone material (where rear face of the stone material was substantially smooth and free from grooves or recesses)”. Clearly, the reason that the earlier claims were allowed was because the rear face of the stone slab was free from

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grooves or recesses and there was a layer of reinforcing material between the linear non-twisted members and the rear face of the slab. The exclusion of such language in the reissue claims clearly is an attempt by applicant to recapture subject matter which was surrendered in the patented file and such is not proper in a reissue application.

2. This application is objected to under 37 CFR 1.172(a) as the assignee has not established its ownership interest in the patent for which reissue is being requested. An assignee must establish its ownership interest in order to support the consent to a reissue application required by 37 CFR 1.172(a). The assignee's ownership interest is established by:

(a) filing in the reissue application evidence of a chain of title from the original owner to the assignee, or

(b) specifying in the record of the reissue application where such evidence is recorded in the Office (e.g., reel and frame number, etc.).

The submission with respect to (a) and (b) to establish ownership must be signed by a party authorized to act on behalf of the assignee. See MPEP § 1410.01.

An appropriate paper satisfying the requirements of 37 CFR 3.73 must be submitted in reply to this Office action.

3. The amendment submitted 4-21-00 where the claims were amended is not in proper form. In a reissue application, the claims (including amended claims) must be submitted in underlined form and any deletions in the claims are not bracketed (they simply should not appear in the

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claim). While the amendment has been entered, applicant is required to resubmit the amendment to the claims with the claims in proper form.

Claim Rejections - 35 USC § 103

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 21-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over E.P. 255,795 in view of Japanese Patent 3-247852, optionally further taken with Japanese Patent 6-64076 for the same reasons as expressed in paper no. 2, paragraph 5.

6. Claims 8-13 and 26-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over E.P. 631,015 in view of Japanese Patent 6-64076, Japanese Patent 3-247852 and E.P. 255,795 for the same reasons as expressed in paper no. 2, paragraph 6.

Response to Arguments

7. Applicant's arguments filed 4-21-00 have been fully considered but they are not persuasive.

The applicant argues regarding the recapture rejection that the claims of the original application did not include the limitation of hardening of the resin and that it was this added limitation in claim 1 which distinguished the same over the prior art and made the same allowable and that the claims at hand are narrower in a sense (they require hardening of the resin) which was

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not required of the claims in the original application. The applicant's arguments in this regard are not persuasive. To begin with, as clearly set forth in the examiner's reasons for allowance and as argued by applicant in the response dated 12-23-96, the claims in the patented file were allowed because none of the prior art of record taught or suggested the placement of a reinforcement between the slab rear face and the non-twisted linear reinforcing members where the rear face of the slab was free from grooves or recesses. How applicant can assert that it was the hardening of the resin which made claim 1 allowable is not clear when one reviews the patented file.

Additionally, while claim 7 was originally rejected (which included the addition of the reinforcement between the slab and the non-twisted linear reinforcing members), after reconsideration (and based upon the arguments presented by applicant in the patented file) it was found that such limitations (including the newly presented limitation that the rear surface of the slab was free from recesses or grooves) defined over the rejection of claim 7. Clearly, the patented file indicated that claim 1 was allowed for these reasons and not merely because applicant recited hardening of the resin (which it should be pointed out was not mentioned at all in the reasons for allowance in the file).

The applicant additionally argues that while the reissue claims are broader in a sense (which does not include the limitations relating to the rear of the stone being free from grooves or recesses and does not require the placement of an additional reinforcement between the non-twisted linear members and the slab), the claims in the reissue are substantially narrower in a sense which related to the hardening of the resin. This is not the case. The claims which issued in

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the patented file all included the limitation of hardening of the resin and thus the claims of the reissue are not narrower in this sense at all. The applicant's argument's regarding the recapture of subject matter which applicant gave up in the patented file are not persuasive.

The applicant argues regarding the prior art that the reference to E.P. '795 failed to teach a smooth surface onto which the reinforcing layer was applied. The applicant is advised that as depicted in Figures 9, 11, 12, and 13 the surface of the slabs were flat (and appear to be smooth). The applicant is advised that the ordinary artisan would have expected that the thin layers of slab material would have been flat and smooth subsequent to the cutting operation and thus would have understood that after the sawing treatment the stone slabs were in fact smooth.

The applicant argues that the Japanese Patent '852 taught the coating of a mat or cloth with a plaster resin and that there is no call for laminating of the fiber reinforced layer. The applicant is advised that the reference does not use a plaster resin but rather employed a thermosetting resin to impregnate the reinforcement and additionally that while the layer of reinforcement was impregnated and laminated upon the stone backing this is the same operation performed by applicant with the reinforcement. The resin was coated upon the reinforcement and the reinforcement was disposed adjacent the rear face of the slab and the resin was hardened. The hardening of the resin would have laminated the reinforcement of the claimed invention to the rear of the slab. While the claims do not expressly recite a laminating step, it naturally flows that this is what is transpiring in the claimed invention. Whether the fibers had the resin therein before or after association with the stone slab is not of import and the reference made it clear that the layers

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were either assembled and impregnated once assembled or they were formed into a prepreg and then attached. Note that the reference did suggest the amount of resin to the amount of reinforcement desired in such a product. To provide this resin ratio in the E.P. '795 would have been obvious.

Regarding Japanese Patent '076, the reference was merely cited to further evidence that the rovings in E.P. '795 would have been non-twisted. The applicant is additionally advised that while layer 102 included resin therein that the application of resin upon the dry fiber layer of the claims would have resulted in the inclusion of resin in the non-twisted fiber reinforcement layer of the claimed invention. In any event, the claims at hand do not exclude the use of resin in the non-twisted linear reinforcement layer and additionally while the layer 104 included reinforcement therein the applicant's claimed resin layer did not exclude the addition of reinforcement within the same. The claims are not commensurate in scope with the applicant's arguments and the reference again clearly suggested that one would have incorporated non-twisted linear reinforcement in a stone panel.

The rejection of claims 1-7 and 14-20 has been removed as these claims all require that the rear face of the slab does not contain any recesses or grooves and the reference to E.P. '015 clearly included the same.

The applicant argues that the only claims which require the grooves are claims 28 and 29, however claims 28-33 (note that claim 30 recites that there are grooves or recesses therein) required the same. Additionally, to provide multiple layers of reinforcement would have been

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within the purview of the ordinary artisan. The applicant argues that because claim 21 is allowable over the other references that claim 26 is allowable as well, however as noted above claim 21 is not allowable over the prior art of record.


Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeff Aftergut whose telephone number is (703) 308-2069.

JHA
May 24, 2000


JEFF AFTERGUT
PRIMARY EXAMINER
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